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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,477	10/06/2001	M. Keith Sharp	11114-4	5317

7590 06/03/2003
JANET A. PIOLI
BRINKS HOFER GILSON & LIONE
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CHICAGO, IL 60611

EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,477

Applicant(s)

SHARP, M. KEITH

Examiner

Matthew F DeSanto

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

Figures 1, 2, 3, 15 should be designated by a legend such as —Prior Art—instead of “conventional needle” because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The 112 Rejections were withdrawn because of the amendments made by the Applicant.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Doyle et al. (USPN 6009933).

Doyle et al. disclosed a hypodermic needle used with a hypodermic syringe, wherein the needle comprises a hollow tube having an angled end with respect to a longitudinal axis of the tube, the end having an opening surrounded by an external peripheral rim, and where the external peripheral rim is beveled back at least 50%, to

form an internal beveled surface, as well as the method of making the needle and a method of use. (Figures 1, 2, 3, 5, and entire reference).

As to claim 6, wherein the internal beveled surface is curved. (Figure 1 and 2).

As to claims 8, and 9, wherein the internal beveled surface surrounds 20-70% of the opening. (Figure 1 and 2).

3. Claims 1-7, and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (USPN 3064651).

Henderson disclosed a hypodermic needle used with a hypodermic syringe, wherein the needle comprises a hollow tube having an angled end with respect to a longitudinal axis of the tube, the end having an opening surrounded by an external peripheral rim, and where the external peripheral rim is beveled back at least 50%, to form an internal beveled surface, as well as the method of making the needle and a method of use. (Figures 1, 2, 3 and entire reference).

As to claim 6, wherein the internal beveled surface is curved. (Figures 1 and 2).

As to claims 8, and 9, wherein the internal beveled surface surrounds 20-70% of the opening. (Figures 1 and 2).

4. Claims 1-7 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Vermed (FR 2757405).

Vermed disclosed a hypodermic needle used with a hypodermic syringe, wherein the needle comprises a hollow tube having an angled end with respect to a longitudinal

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axis of the tube, the end having an opening surrounded by an external peripheral rim, and where the external peripheral rim is beveled back at least 50%, to form an internal beveled surface, as well as the method of making the needle and a method of use (Entire reference).

As to claim 6, wherein the internal beveled surface is curved (Entire reference).

Response to Arguments

5. Applicant's arguments filed 3/19/03 have been fully considered but they are not persuasive with regards to Doyle and Henderson.

6. Doyle and Henderson both disclose the claimed invention except for exact dimensions given in the claim. The examiner disagrees with regards to Doyle for the reason that the internal beveled surface is the circumference 38a to 38b and therefore would fall into the range of the claimed invention. With regards to Henderson the examiner cannot find in the reference where it is stated that the internal beveled surface surrounds less than 20 percent of the opening. The examiner also relies on case law to further support the rejections.

7. . In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

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8. Applicant's arguments, with respect to Barrett and Huber have been fully considered and are persuasive. The 102 rejections have been withdrawn.

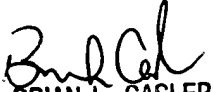
Conclusion

9. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 3/19/03 prompted the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.


Matthew DeSanto
Art Unit 3763
May 30, 2003


BRIAN L. CASLER
SUPERVISORY EXAMINER
TECHNOLOGY CENTER 3760